

## **REMARKS**

Reconsideration of the subject application as amended herein is respectfully requested for the reasons discussed herein. In the Office Action mailed on June 7, 2004, the Examiner has objected to the drawings under 37 C.F.R. 1.83(a) for failing to show each feature of the invention that is specified in the claims. Furthermore, the Examiner has rejected pending claims 1 through 20 under 35 U.S.C. §102 and §103 based upon the disclosures of U.S. Patent No. 5,325,545 (Hirano) and U.S. Patent No. 4,106,126 (Traenkle).

As discussed in more detail below, Applicant has cancelled claim 20 which renders the Examiner's objection under 37 C.F.R. 1.83(a) moot. Furthermore, Applicant has amended independent claim 1 to define a structure which is not found in the prior art. In particular, the prior art neither discloses nor suggests a sock having a three dimensional object attached near the opening of the sock wherein the stuffing conforms to the shape of the three dimensional object, said shape being primarily determined by the skin forming the object filled with the stuffing. The Examiner's rejections of the remaining claims are also addressed in further detail below.

### **I. OBJECTION TO THE DRAWINGS**

The Examiner has objected to the drawings under 37 C.F.R. 1.83(a) since the drawings purportedly fail to show all of the features recited in Applicant's claim 20. In light of Applicant's cancellation of claim 20, the Examiner's objection is moot and Applicant's drawings are in compliance.

## II. CLAIM REJECTIONS -- 35 U.S.C. §102

An invention is anticipated under §102 if the same device, including all the claim limitations, is shown in a single prior art reference. *Richardson v. Suzuki Motion Co. Ltd.* 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989). Every element of the claimed invention must be literally present, arranged as in the claim.

*Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 973 (Fed. Cir. 1984) *cert. denied*, 469 U.S. 857 [225 USPQ 792] (1984); *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771-772, 218 USPQ 781, 789 (Fed Cir. 1983) *cert. denied*, 465 U.S. 1026 [224 USPQ 250] (1984). The identical invention must be shown in as complete detail as is contained in the patent claim *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560, 225 USPQ 253, 256 (Fed. Cir. 1985); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). For the following reasons, Applicant requests that the Examiner reconsider the rejection of the claims as amended.

Applicant respectfully submits that independent claim 1, as amended herein, defines structure not found in the prior art. In particular, the prior art does not teach or suggest “a three-dimensional object, having a three-dimensional shape when stuffed, attached to the sock near the foot opening, said object including a skin, and stuffing which conforms to said shape of said object, said three-dimensional shape of said object being primarily determined by said skin filled with said stuffing,” as required by amended claim 1.

The Examiner has rejected claim 1 pursuant to 35 U.S.C. §102 based on the disclosure of U.S. Patent No. 5,325,545 (Hirano).<sup>1</sup> Applicant submits that Hirano does not teach the aforementioned elements of Applicant's invention, and in fact, teaches a sock having a three-dimensional object with a shape that is primarily determined by the dimensions of the stuffing that is used, rather than by the skin that is filled with a stuffing.

In the Office Action, the Examiner states:

Hirano provides a three dimensional object attached to the sock near the foot opening and the object including a skin and stuffing...Also provided on the sock of Hirano is indicia being related visually to the stuffed object. The indicia is in the form of an animal face and is formed by drawing a pattern on the sock with yarn of a different color, sewing a piece of cloth or button, or by forming protruding recesses during the knitting process.

Office Action, p. 3. While the Examiner characterizes Hirano as disclosing a three-dimensional object which incorporates stuffing attached to a sock, Hirano fails to disclose that the stuffing conforms to the shape of the three dimensional object and that the shape is determined by the skin, generally independent of the stuffing that is used, as required by amended claim 1. Indeed, Hirano teaches the reverse, namely, the use of knitted bags which can be stretched relatively freely to change their shape such that when circular stuffing is used in the inside of the bags, the bags become circular, that is, they conform to the shape of the stuffing. Column 2, lines 51-62. Since the bags are of knitted material, the

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<sup>1</sup> Claims 7, 11 and 13 have also been rejected under 35 U.S.C. §102. However, in light of Applicant's arguments with respect to independent claim 1, as amended, which are set forth herein, Applicant believes that all of the remaining pending claims are distinguishable over the prior art and are in condition for allowance.

stuffing utilized in said bags is what primarily determines the shape of the ears disclosed in Hirano.

Contrary to Hirano, the skin of Applicant's socks, and not the stuffing, primarily determines the shape of the three-dimensional object. The stuffing as used in Applicant's sock is merely used to fill out the shape that is formed by the skin, and it does not dictate the shape that is formed thereby. In support of Applicant's assertions, the specification expressly discloses the ability of the three-dimensional object attached to the sock to assume relatively complex shapes by virtue of the use of a skin (p. 4, lines 5-7). It is this use of a skin that provides the potential to produce many more styles and embodiments than were previously possible in conventional socks having three-dimensional objects attached thereto (p. 5, lines 4-6). Applicant also refers to the "use of a skin 24, following well-known techniques for making stuffed objects, enables the ornament to assume shapes that are more intricate and multifaceted." p.7, lines 11-14.

Based on the foregoing Applicant submits that claim 1, as amended, is allowable over the prior art. Since Applicant's claims 7, 11 and 13 depend from claim 1 which has heretofore been distinguished from the prior art, these claims should be allowed as well.

### **III. CLAIM REJECTIONS -- 35 U.S.C. §103**

It is well established that the Examiner bears the initial burden of demonstrating a *prima facie* case of obviousness under §103. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976). To this end, the *prima facie* case

requires, *inter alia*, some suggestion or motivation to modify or combine the references based upon the prior art or a general knowledge in the field. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). Statements in the prior art as well as the inferences that those skilled in the art would be reasonably expected to draw, may form the basis of such suggestions. *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA1968). However, the simple fact that an apparatus is capable of being modified to perform a claimed feature is insufficient as a basis for a non-obvious rejection without some suggestion to do so. *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430 (Fed. Cir. 1990). “[A]n examiner cannot establish obviousness by located references which describe various aspects of a patent applicant’s invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.” *Ex parte Levengood*, 28 USPQ2d 1300, 1301 (Bd. Pat. App. & Int. 1993).

In the matter *sub judice*, the Examiner has not made a prima facie case of obviousness with respect to claims 2-6 because, contrary to the Examiner’s assertion, it is not simply a matter of design choice to provide three-dimensional objects in the shape of a “miniaturized toy, an animal head, an animal, an electronic device, or a cellular phone.” As discussed above, Applicant’s invention addresses the unique problem of providing three-dimensional objects that are capable of assuming relatively complex shapes by virtue of utilizing a skin that is not found anywhere in the prior art.

Hirano merely discloses the use of relatively simple geometric shapes in forming a three-dimensional object. Furthermore, the three-dimensional objects formed in Hirano appear to be limited to the ears of an animal, which are likewise very simple to simulate. Notably, Hirano discloses that when circular, elliptical or triangular shaped ears are desired, correspondingly shaped stuffings are provided, as shown in FIGs. 4 through 6 of Hirano. Column 3, lines 1-16. Thus, Hirano fails to disclose the ability to form complex shapes. Such limitations on the formation of complex shapes is a deficiency in the prior art which Applicant's invention has overcome. Accordingly, it cannot simply be a matter of design choice to provide the objects recited in claims 2-6 as the three-dimensional objects attached to the sock.

Since Applicant's claims 8-10, 12 and 14-19, which were also rejected under 35 U.S.C. §103, depend either directly or indirectly from claim 1 which has heretofore been distinguished from the prior art, these claims should be allowed as well. Further, in light of Applicant's cancellation of claim 20, the Examiner's rejection of claim 20 under 35 U.S.C §103 is rendered moot.

#### **IV. NEW CLAIM**

Finally, applicant has added new independent claim 21 for consideration by the Examiner. Applicant respectfully submits that this claim also incorporates limitations not found in the prior art and is thus allowable. No additional filing fees are believed to be necessitated by the addition of new claim 21, in light of the cancellation of claim 20.

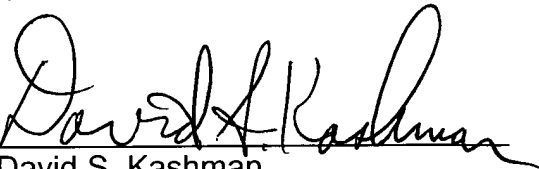
## V. CONCLUSION

Accordingly, it is respectfully submitted that claims 1-19 and 21 are patentably distinguishable over the prior art, and that the subject application is in condition for allowance.

The Commissioner is requested to construe this paper as including a retroactive petition for a one-month extension of time in which to file a response to the outstanding Office Action, and accordingly, a check for the official fee of \$55.00, prescribed therefor by 37 C.F.R. §1.17(a)(1), in the case of a small entity, is also submitted herewith. The Commissioner is authorized to charge any additional extension fees which may be required, or to credit any overpayment, to Deposit Account No. 07-1730.

Respectfully submitted,

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Dated: New York, New York  
October 7, 2004

## CERTIFICATE OF MAILING

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